

REMARKS

Reconsideration is respectfully requested.

Claim Amendments

In this Amendment, applicants have amended claims 1, 3-5 and 17, and added new claims 21-31. Applicant is not conceding that the subject matter encompassed by claims 1, 3-5 and 17 prior to this Amendment is not patentable over the art cited by the Office. Claims 1, 3-5 and 17 were amended in this Amendment solely to facilitate expeditious prosecution the application. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by claims 1, 3-5 and 17, as presented prior to this Amendment and additional claims in one or more continuing applications.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 3-5 and 17 were rejected under 35 U.S.C. 103 as being unpatentable over Matheny et al. (US 2002/0161883) in view of Goringe et al. (US 2003/0046427). Applicants respectfully traverse.

Section 103 requires the issuance of a patent unless “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383

U.S. 1, 17-18, 148 USPQ 459, 467 (1966). See also *KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”).

The USPTO bears the initial burden of establishing that a claimed invention is prima facie obvious. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). To establish a prima facie case of obviousness, the USPTO must satisfy three requirements. First, it must “identify a reason that would have prompted a person of ordinary skill in the relevant art to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, *supra*. Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Third, the prior art reference or combination of references must teach, suggest or otherwise render obvious all the limitations of the claims considered as a whole. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

On October 10, 2007, the USPTO issued new examination guidelines for determining obviousness under 35 U.S.C. 103 in view of the *KSR* case. Federal Register, Vol. 72, No. 195, pages 57526-57535. The examination guidelines emphasize that “the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge.” Fed. Reg., Vol. 72, No. 195 at page 57527. The examination guidelines point out on page 57527 that “[i]n certain circumstances, it may also be important to include explicit findings as to how a person of

ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done.” As additionally stated on page 57527, “[f]actual findings made by Office personnel are the necessary underpinnings to establish obviousness.”

Scope And Content of Matheny et al.

Matheny et al. discloses a system wherein plural agents are given overlapping discovery assignments. As stated in lines 3-5 of Matheny’s paragraph [0025], “[t]he same device may be discovered multiple times, by different discovery agents.” Matheny’s claim 1 likewise recites that the discovery data includes “two or more duplicate data entries,” which requires “removing all but one of the duplicate data entries from the discovery document.” The Examiner acknowledges this in the section 103 rejection by noting that Matheny et al. “fails to disclose said discovery assignments being non-overlapping.”

Scope and Content of Goringe et al.

Goringe et al. discloses a system wherein two discovery agents 308 and 310 (see Fig. 3) are respectively capable of discovering SNMP-MIB information and OSPF information. The full discovery capabilities of each agent are utilized to conduct discovery, just as in Matheny et al. The only difference is that the agent discovery capabilities in Goringe et al., are non-overlapping, which necessitates that their discovery assignments must also be non-overlapping.

Claim 1

Claim 1 has been amended to clarify that the claimed system has discovery agents with overlapping discovery capabilities but (1) no network device is discovered more than once by different discovery agents seeking the same information, (2) one or more agents are not permitted to perform full discovery of information due to one or more other discovery agents

being assigned to discover the same information, and (3) no duplicate discovery information is generated. Support for this amendment is provided by page 12, line 12 – page 14, line 5 of the specification and Figs. 5, 6A and 6B of the drawings.

The section 103 rejection states that it would have been obvious to modify Matheny et al. using Goringe et al. so that the Matheny et al. discovery agents do not perform overlapping discovery. However, Goringe et al. would not have motivated this modification because Goringe et al. teaches that the full discovery capabilities of discovery agents should be utilized to perform discovery, just as Matheny et al. does. A person of ordinary skill in the art would not have been led by Goringe et al. to modify Matheny et al. so that the agents of the latter reference no longer perform full discovery. In Goringe et al., the only reason the agents 308 and 310 perform non-overlapping discovery is because they **have to** (given their non-overlapping discovery capabilities). Goringe et al. thus does not teach, suggest, motivate or otherwise render obvious the idea of limiting the discovery assignments of agents in order to achieve non-overlapping discovery. Again, the non-overlapping discovery of Goringe et al. simply follows from the non-overlapping discovery capabilities of the agents. Goringe et al. also fails to teach, suggest, motivate or otherwise render obvious the idea of one or more agents not being permitted to perform full discovery of information due to one or more other discovery agents being assigned to discover the same information (as now recited in amended claim 1).

Based on the foregoing differences, it cannot be said that the subject matter of claim 1 would have been obvious in view of the cited references. Accordingly, it is respectfully requested that the rejection of claim 1 be withdrawn.

Claim 3

Amended claim 3 should be allowable based on its dependence from claim 1. In addition, the cited references do not render obvious the amended claimed subject matter wherein discovery assignments are based on a determination of which discovery agents having overlapping discovery capabilities are most fit to receive discovery assignments. Support for this amendment is provided by page 19, lines 3-6 and page 23, lines 16-19 of the specification. As stated, Matheny et al. does not make non-overlapping discovery assignments. Goringe et al. only makes discovery assignments based on full agent capabilities, and thus does not make any determination regarding agent assignments.

Claim 4

Amended claim 4 should be allowable based on its dependence from claim 1. In addition, the cited references do not render obvious the claimed subject matter wherein discovery assignments reflect one or more of data collection service registrations in which a network manager in said system registers with said plural discovery agents to receive specified discovery information, agent cost to obtain network information, load balancing among said plural discovery agents, and assignment churn. Support for this amendment is provided by page 24, line 18 – page 25, line 7 of the specification. The final rejection states that Matheny et al. discloses a registration operation for registering agents for data collection. Claim 4 has been amended to recite that a network manager registers with plural discovery agents. Matheny et al. discloses no such registration by a network manager with an agent. Matheny et al. only discloses agent registration with a discovery database.

Claim 5

Amended claim 5 should be allowable based on its dependence from claim 1. In addition, the cited references do not render obvious the claimed subject matter wherein discovery assignments comprise both inband and outband discovery assignments. Inband and outband discovery agents are discussed on page 8, line 6 – page 10, line 8 of the specification. The final rejection cites paragraph [0011] of Matheny et al. in rejecting claim 5. Neither this paragraph nor any other paragraph of Matheny et al. mentions inband or outband discovery. Although paragraph [0011] of Matheny et al. discusses SNMP discovery, which is a type of outband discovery, there is reference to anything called outband discovery.

Claim 17

Independent claim 17 distinguishes over the cited references due to its recitation of discovery capability logic providing agent discovery capability information to a requester that is a subset of all discovery information obtainable by said agent. Support for this claim element is provided by page 16, line 6 – page 17, line 2 of the specification. Paragraph [0019] of Matheny et al. is cited as disclosing this claim element. The claim element is also discussed in the Examiner's response to arguments. Note that claim 17 deals with a discovery agent. The claim element in question refers to discovery capability logic in the discovery agent that **provides** the subset discovery capability information [e.g., to a network manager]. In Matheny et al., a discovery agent registers its full capabilities in the discovery database. Thus, it only provides information about its full capabilities, not a subset thereof. That the network manager subsequently searches on a subset of the agent's range of IP addresses is irrelevant. The network manager is simply selecting the discovery information it wants from the **full set of**

discovery information previously provided by the agent. Thus, this element of claim 17 is not met.

Independent claim 17 has also been amended to clarify that the claimed discovery agent has agent discovery capability that overlaps the discovery capability of one or more other network discovery agents, and said discovery queries utilize non-overlapping discovery assignments relative to said other discovery agents, such that (1) no network device is discovered more than once by different discovery agents seeking the same information, (2) said discovery agent performs discovery of some information that said other discovery agents are not permitted to obtain, and (3) no duplicate discovery information is generated. Support for this amendment is provided by page 12, line 12 – page 14, line 5 of the specification and Figs. 5, 6A and 6B of the drawings. This claim element of claim 17 distinguishes over the cited references.

In particular, Goringe et al. teaches that the full discovery capabilities of discovery agents should be utilized to perform discovery, just as Matheny et al. does. A person of ordinary skill in the art would not have been led by Goringe et al. to modify Matheny et al. so that the agents of the latter reference no longer perform full discovery. In Goringe et al., the only reason the agents 308 and 310 perform non-overlapping discovery is because they **have to** (given their non-overlapping discovery capabilities). Goringe et al. thus does not teach, suggest, motivate or otherwise render obvious the idea of limiting the discovery assignments of agents in order to achieve non-overlapping discovery. Again, the non-overlapping discovery of Goringe et al. simply follows from the non-overlapping discovery capabilities of the agents. Goringe et al. also fails to teach, suggest, motivate or otherwise render obvious the idea of one

agent performing discovery that other agents are not being permitted to perform even though they are capable of doing so.

Based on the foregoing differences, it cannot be said that the subject matter of claim 17 would have been obvious in view of the cited references. Accordingly, it is respectfully requested that the rejection of claim 17 be withdrawn.

New Claims

New dependent claims 21-31 are presented. These claims are also believed to distinguish over the cited references. No new matter has been presented because each claim is supported by the application as originally filed.

Support for claims 21 and 22 is provided by page 12, line 12 – page 14, line 5 of the specification and Figs. 5, 6A and 6B of the drawings.

Support for claim 23 is provided by page 14, lines 18-22 of the specification.

Support for claim 24 is provided by page 20, line 3 – page 23, line 8 of the specification.

Support for claim 25 is provided by page 21, line 12 – page 22, line 7 of the specification.

Support for claim 26 is provided by page 22, line 8 – page 23, line 8 of the specification.

Support for claim 27 is provided by page 14, lines 11-17 of the specification and Fig. 7A of the drawings.

Support for claim 28 is provided by page 16, lines 6-10 of the specification.

Support for claim 29 is provided by page 14, lines 11-17, page 15, lines 1-6, and page 16, line 6 – page 17, line 2 of the specification, and Figs. 7A and 7B of the drawings.

Support for claim 30 is provided by page 15, line 12 – page 16, line 5 of the specification and Fig. 8 of the drawings.

Support for claim 31 is provided by page 25, line 9 – page 27, line 8 of the specification.

In view of the foregoing, Applicants respectfully request that all rejections be withdrawn and that Notices of Allowability and Allowance be issued.

Respectfully submitted,

/Walter W. Duft/

Walter W. Duft
Attorney for Applicant
Registration No. 31,948

Law Offices of Walter W. Duft
8616 Main Street, Suite 2
Williamsville, New York 14221
Telephone: (716) 633-1930
Facsimile: (716) 633-1932